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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,725	02/21/2003	Moshe Ben-Chorin	P-2685-US	2720
26304	7590	08/24/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			HAMDAN, WASSEEM H	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/089,725	Applicant(s) BEN-CHORIN ET AL.	
	Examiner Wasseem H Hamdan	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/12&16/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodi (US Patent 5,806,430).

Regarding claim 1, Rodi discloses a system for elimination of printing registration errors [Fig. 1; column 2, line49-56], comprising:

a processor [6] for computing distortion parameters and an imaging system in communication with said processor and configured for exposing distorted images [FIG. 1; column 2, lines 57-67; column 3, lines 1-5],

wherein the processor [6] is programmed for:

receiving input data including paper data, at least one machine parameter and ink distribution data, the processor calculating image dependent errors from said input data [the elements 4, 5, and 6 are capable of performing the claimed functional limitation, please see below the section of “Response to Arguments / Remarks”];

receiving at least one fixed error map dependent on machine parameters and obtained during a calibration run [the elements 4, 5, and 6 are capable of performing the claimed functional limitation, please see below the section of “Response to Arguments / Remarks”];

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predicting registration errors based on the fixed error map and said image dependent errors [the elements 4, 5, and 6 are capable of performing the claimed functional limitation, please see below the section of “Response to Arguments / Remarks”]; and

computing distortion parameters based on said registration errors for creating distorted images [column 2, lines 60-67; column 3, lines 1-5; the elements 4, 5, and 6 are capable of performing the claimed functional limitation].

Regarding claim 3, Rodi discloses wherein said ink distribution data for an image file to be exposed is provided by a low resolution image file derived from said image file [the elements 4, 5, 6 and 7 are capable of performing the claimed functional limitation, please see below the section of “Response to Arguments / Remarks”].

Regarding claim 4, Rodi discloses where said imaging system includes a strobe card configured for changing timing signals [the elements 4, 5, 6 and 7 are capable of performing the claimed functional limitation, please see below the section of “Response to Arguments / Remarks”].

Regarding claim 5, Rodi discloses wherein said exposure system includes means for changing the resolution of an image [the elements 4, 5, 6 and 7 are capable of performing the claimed functional limitation, please see below the section of “Response to Arguments / Remarks”].

Allowable Subject Matter

3. The following is an examiner's statement of reasons for allowance: Claims 6-9, are allowable.

Regarding claim 6, the prior art of record does not teach all the combined steps of a method for eliminating printing registration errors in a system including the step of receiving input data including paper data, at least one machine parameter and ink distribution data; calculating image dependent errors from said input data; receiving at least one fixed error map dependent on machine parameters and obtained during a calibration run; predicting registration errors based on the fixed error map and said image dependent errors; and computing distortion parameters based on said registration errors for creating distorted images.

4. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments / Remarks

5. Applicant's remarks filed on 06/16/2004 have been fully considered but they are not persuasive. The Amendment is insufficient to overcome the prior art of record.

Applicant's arguments on pages 7 and that "In particular, Rodi (430 discloses a system in which the modification treatment of the image data occurs upstream of the raster image processor. In contrast, the present invention as currently claimed, receives the image data and

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determines distortion parameters to be applied to the imaging device so as to produce a distorted image on the printing element thereby ensuring correct registration. As such, Rodi '430 fails to teach or reasonably suggest that the registration correction is performed on the incoming image data before transforming into machine dependent data format, i.e., that modification treatment of the image data occurs downstream of the raster image processor." The argument for newly amended claim 6, and the new claim 9, is moot since the claims are now allowed. Regarding claims 1-5, the examiner respectfully disagrees, because claim 1, is an apparatus claim, and the newly added limitations are functional limitations. The Rodi system is capable of performing the newly added functional limitations of claims 1-5. Therefore the rejection is proper. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable

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of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also MPEP § 2112 - § 2112.02.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H Hamdan whose telephone number is (571) 272-2166. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wasseem Hamdan

August 12, 2004



Daniel J. Colilla
Primary Examiner
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